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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,520	07/20/2001	Samuel Farchione	FSP-10002/08	2097
25006	7590	09/20/2006	EXAMINER	
GIFFORD, KRASS, GROH, SPRINKLE & CITKOWSKI, P.C PO BOX 7021 TROY, MI 48007-7021			MOSSER, KATHLEEN MICHELE	
			ART UNIT	PAPER NUMBER
			3715	

DATE MAILED: 09/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/910,520

Applicant(s)

FARCHIONE, SAMUEL

Examiner

Kathleen Mosser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-43 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-14 and 16-43 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

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DETAILED ACTION

In response to the amendment filed 07/10/2006, claims 1-14 and 16-43 are pending.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 1-14 and 16-43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In order for a claim to be statutory it must show a practical application of an otherwise abstract idea. A practical application may be demonstrated through either (a) showing a physical transformation or (b) otherwise showing a useful, concrete and tangible result. In the present case, there is no physical transformation occurring, each of the steps is intended to occur with the aid of computer system or exclusively through the alteration of data. Further there is no tangible result. In order for a result to be tangible it must be tied to the real world in such a manner as to make the result appreciable to the user or viewer of the system. Although in the instant invention data is received and processing is performed using the data, the result of these steps are never realized in a "real-world" application, (ie of communication to the user), thus there is no real-world practical application of the abstract idea (identifying individual fashion selections).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
2. Claims 1, 5, 6, 8-10, 12-14, 16, 18-21, 24-30, 33, 35-37, 39 and 41-43 rejected under 35 U.S.C. 103(a) as being unpatentable over MacFarlane et al (US 5311293) in view of Fabbri et al (US 4561850) for the reasons set forth in the office action dated 04/10/2006, and incorporated herein by reference.
3. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacFarlane/Fabbri as applied to claim 1 and further in view of Nakamura (US 4987552) for the reasons set forth in the office action dated 04/10/2006, and incorporated herein by reference.
4. Claims 7, 23, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacFarlane/Fabbri as applied above and further in view of Rifkin et al (US 6065969) for the reasons set forth in the office action dated 04/10/2006, and incorporated herein by reference.
5. Claims 11, 21, 31, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacFarlane/Fabbri as applied above and further in view of Thies et al (US 5206804) for the reasons set forth in the office action dated 04/10/2006, and incorporated herein by reference.

Response to Arguments

Applicant's arguments filed 07/10/2006 have been fully considered but they are not persuasive.

Rejection under 35 USC §101

Applicant's arguments assert that the step of "identifying" in the claims produces a useful, concrete and tangible result. In support of this assertion applicant cites the 2005 *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*. Particularly the applicant cites the guidelines "at 21" stating that the tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. The examiner acknowledges this citation, but notes that the pending claims are not being rejected on the premise that the method must be tied to a particular apparatus or must operate to change articles or materials to a different state or thing. The claims are being rejected for failing to produce a result, which has "real-world" value or appreciation, thus failing to be tangible. As explained in the rejection above a method that merely makes an identification of an item from a database without communicating that result to the user, does not result in a real world appreciable result. From the Interim Guidelines:

"The claim must be examined to see if it includes anything more than a §101 judicial exception. If the claim is directed to a practical application of the §101 judicial exception producing a result tied to the physical world that does not preempt the judicial exception then the claim meets the statutory requirement of 35 USC §101."

As explained above, the result of the method is not tied to the physical world. The method of the instant invention makes an identification without communicating that identification outside the system on which it is performed, thus failing to produce a tangible result and therefor being non-statutory.

Rejections under 35 USC §103

Applicant asserts that MacFarlane et al teaches away from the present invention and is not combinable with Fabbri et al except through the use of improper hindsight. Applicant's primary support for this assertion rests on MacFarlane's teaching of using only skin color in the

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determinations, and a upon a citation of MacFarlane which recites other characteristics used in prior art systems. However, none of these citations either taken alone or in combination are sufficient to support the applicant's assertion. In describing the prior art systems MacFarlane states (as cited by applicant):

Recently, numerous proposals for identifying colors of, for example, clothing, makeup, hair colorants, and the like, based upon an individual person's coloration have been put forth. Some of these proposed techniques have taken into account the color of the person's complexion, but have incorrectly emphasized redness and have also wrongly relied upon eye color, color of hair, and even racial background to assign color categories to the person. Based on that assignment a preselected collection of colors of fabric or other materials was chosen.

In this citation MacFarlane teaches that prior art systems are known to use these factors and place an "incorrect emphasis" on the additional attributes, to which the invention is not reliant upon. Contrary to applicant's assertion, this is not a teaching that the use of these features is impermissible, but that the emphasis on them must be proper. MacFarlane also teaches in col. 1: 51+:

Although blue and yellow have been mentioned along with other colors and/or features said to contribute to an assessment of compatible colors, there have been only vague mentions of these broad color families encompassing many different colors in the blue and yellow family.

In this citation MacFarlane teaches that the use of the specific features of his invention (color determination based upon blue and green values in the skin tone) in combination with other features is known in the prior art. Fabbri et al teaches a color determination system which is based on both skin coloration and eye color. Fabbri et al teaches in col. 1: 35-51, that although both features are used that an emphasis is placed on skin color as it is the larger area and eye color is only used to make the determination of contrasting or complimentary colors. When

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determining whether a combination would have been obvious, the examiner must consider the prior art as a whole. In the instant case, the prior art as a whole suggests that the combination of the MacFarlane invention and the Fabbri invention would have been prima facie obvious, as both systems teach that combination was known at the time of applicant's invention. Further, the combination of the two references does not render the invention of MacFarlane dysfunctional. The invention can still be used for its intended purpose, determining color choices based upon skin tone characteristics. The additional features incorporated by use of the Fabbri et al system merely allow for the finer determination being made for complimentary and contrasting colors. For these reasons the rejection of the claims based upon the combination of MacFarlane et al and Fabbri et al are maintained. No additional arguments concern the other rejections under 35 USC §103 have been presented.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The examiner notes that changes have been made to the previous statements of rejection, these modifications have been made only to correct typographical and/or clarity issues present in the previous office action and do not alter the grounds of rejection or supporting rationale.

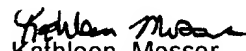
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen Mosser whose telephone number is (571) 272-4435. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Kathleen Mosser
Primary Examiner
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September 15, 2006